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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,027	12/30/2003	Kevin J. Elsken	PO-8044/MD-02-39	8269

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BAYER MATERIAL SCIENCE LLC
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EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,027

Applicant(s)

ELSKEN ET AL.

Examiner

John m. Cooney

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1203.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Lund et al.(5,688,833).

Lund et al. disclose preparations of polyurethane foams having lowered K-factors, superior performance and dimensional stability which are prepared from polyisocyanates, polyol mixtures of the specificity claimed by applicants, 1,1,1,3,3-pentafluoropropane(HFC-245fa), and water (see column 1 lines 47-57, column 2 lines 10-25, column 3 lines 24 et seq., column 4 lines 15-24,and column 5 lines 6-29, as well as, the entire document). Lund et al.'s disclosure is teaching of the instant polyol components and mixtures, HFC-245fa, and water to a degree that anticipation of applicants' combinations and their amounts is seen to be evident. It should be noted that not all of applicants' claims require the presence of every polyol which is recited {note, for example, claim 1's recitations of "up to about..." which are read to be optional inclusions}. The specific K-values of applicants' claims, though not particularly

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specified, are held to be inherent to the teachings of Lund et al. owing to the similarities in the materials employed.

Claims 1-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Schilling et al.(6,846,850), Doerge et al.(6,562,880), and Schilling (6,423,759), each taken individually.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Patentees disclose preparations of polyurethane foams which are prepared from polyisocyanates, polyol mixtures of the specificity claimed by applicants, 1,1,1,3,3-pentafluoropropane(HFC-245fa), and water (see each of the documents in their entirety). Each of the patents' disclosures is teaching of the instant polyol components and mixtures, HFC-245fa, and water to a degree that anticipation of applicants' combinations and their amounts is seen to be evident. The specific K-values of applicants' claims, though not particularly specified, are held to be inherent to the teachings of each of the patents owing to the similarities in the materials employed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,846,850, claims 1-14 of U.S. Patent No. 6,562,880, and claims 1-17 of U.S. Patent No. 6,423,759, each taken individually. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims and the teaching effects of the supporting disclosure disclose preparations of polyurethane foams which are prepared from polyisocyanates, polyol mixtures of polyethers and polyesters, 1,1,1,3,3-pentafluoropropane(HFC-245fa), and water wherein it would have been obvious for one having ordinary skill in the art to have varied the combinations and their respective amounts within the claims of the patents with expectation of success in order to arrive at the products and processes of applicants' claims in the absence of a showing of new or unexpected results.

Claims 1-48 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2,5,8, and 11-13 of copending Application No. 10/894,692, claims 1-9 of copending Application No. 10/965,349, claims 1-24 of copending Application No. 10/281,733, claims 1-8 of copending Application No. 10/295,315, each taken individually. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims and the teaching effects of the supporting disclosure disclose preparations of polyurethane foams which are prepared from polyisocyanates, polyol mixtures of polyethers and polyesters, 1,1,1,3,3-pentafluoropropane(HFC-245fa), and water wherein it would have been obvious for one having ordinary skill in the art to have varied the combinations and their respective amounts within the claims of the applications with the expectation of success in order to arrive at the products and processes of applicants' claims in the absence of a showing of new or unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

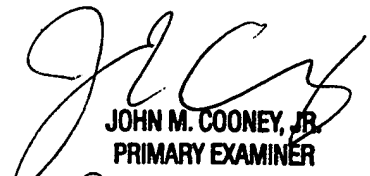
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Heinemann et al. is cited for its disclosure of interesting materials in the related polyurethane art.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700